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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,347	04/12/2001	Rabindranath Dutta	AUS920010214US1	3791

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EXAMINER

KESACK, DANIEL

ART UNIT	PAPER NUMBER
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3691

NOTIFICATION DATE	DELIVERY MODE
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05/02/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

Office Action Summary	Application No. 09/833,347	Applicant(s) DUTTA ET AL.	
	Examiner Daniel Kesack	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 16, 17, 19-30, 34-45, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 16, 17, 19-30, 34-45, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response to non-final rejection, filed February 12, 2008 has been entered. The amendments and arguments have been fully considered. Claims 1-12, 16, 17, 19-30, 34-45, 49 and 50 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 5-8, 16, 19, 23-26 and 34, 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde, Jr., U.S. Patent No. 6,038,553, in view of Cahill et al.,

U.S. Patent No. 5,678,046, and further in view of Ozaki et al., U.S. Patent No. 5,933,478.

Claims 1, 16, 19, 34, Hyde teaches a system and method of cashing checks without human intervention, comprising receiving a check from a user at an automatic teller machine (column 4 lines 52-57), scanning the check to generate an image (column 5 lines 3-6), transmitting the image to a financial institution data processing system (column 5 lines 3-6), performing a transaction involving the check at the financial institution data processing system to generate a transaction result (column 5 lines 15-23), and transmitting the transaction result to the automatic teller machine (column 6 lines 27-32).

Claims 7, 8, 35, 36, 40, 41, Hyde further teaches capturing an image of a user at an automatic teller machine and stores the information along with both sides of the scanned check within the check cashing database.

Hyde fails to teach transmitting the image of the checks, the image of the user, and the transaction result.

Cahill discloses a system and method for distributing electronic check images to a user. Cahill teaches check images are faxed to a payee's fax machine (column 7 line 64 – column 8 line 5). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hyde to include sending

the check cashing data captured according to Hyde from the ATM to the user's fax machine because Cahill details the reasons it is desirable to archive electronic versions of checks, and the method taught by Cahill is "a significant improvement in the time it takes to prepare correspondence and send it to a payee" (column 8 lines 3-5). It would be an obvious next step to include the user picture which is stored along with the check images because of the security benefits attained by maintaining the user's image.

Hyde and Cahill fail to teach transmitting the image and the transaction result to a mobile device associated with the user.

Ozaki discloses a system and method for receiving fax image data on a handheld device from a communication server. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hyde and Cahill to include receiving the images on a handheld device because such a combination would yield predictable results.

Claims 5, 6, 23, 34, 38, 39, Sending statements to an account holder, as taught by Cahill, is considered sending an alert for the transaction, including identification of the transaction, and the account being updated based upon the transaction result. A statement is known to include transactions completed within the timeframe of the statement. Furthermore, it is old and well known that if the account has multiple names associated therewith, the statement will be sent to all accountholders.

5. Claims 2-4, 20-22, 35-37, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde, Jr., Cahill et al., and Ozaki et al., as cited above, and further in view of "The XML Files".

Hyde, Cahill, and Ozaki fail to teach importing the image and transaction result into an end user financial program.

"The XML Files" discloses receiving a bank statement in a format which is easily imported into bank reconciliation software (p76, column 2, paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Cahill to include emailing a bank statement in such a format to the user because providing such a formatted document along with the image of the check makes it more convenient for the user to archive the check information, which is a problem with which Cahill is concerned.

While "The XML Files" does not disclose where the bank reconciliation software is located, Applicant's specification discloses that it is known in the art that bank reconciliation software (Quicken) may be located on mobile devices, as well as other processing system. Furthermore, it is old and well known in the art that data kept on mobile devices such as PDAs may be transferred to a non-mobile device. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Cahill to include transmitting the received data to another data

processing system because it is desirable that a user back up important data such as financial statements.

Response to Arguments

6. Applicant's arguments filed February 12, 2008 have been fully considered but they are not persuasive.

Regarding claim 1, Applicant argues that there is an error in making the Hyde/Cahill combination.

Applicant argues that ATM devices would have no ability to receive a fax, and therefore one of ordinary skill in the art would not be motivated to combine the references. Furthermore, Applicant argues that there is no reason to fax the scanned check image to Hyde's ATM, and would serve no purpose. Examiner respectfully disagrees, at least because Applicant appears to have misunderstood the combination as cited by the Examiner.

The combination, as cited by Examiner, involves the check cashing system as taught by Hyde combined with the image storage and retrieval system as taught by Cahill. Examiner is of the opinion that it would be obvious to combine the image storage and retrieval system of Cahill, with the ATM of Hyde. Therefore, in Examiner's

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combination, the system of Cahill is not faxing anything to the ATM of Hyde. Rather, the ATM incorporates the features of the Cahill system, and the combination would allow faxing of images from the ATM to a user's fax receiving device. Furthermore, the Ozaki reference is cited for its teaching that a mobile device can be used as a fax receiving device. It would have been obvious to incorporate the features of the Cahill system into the ATM of Hyde because the Cahill system is described in terms of "placing a plurality of documents in a document imaging machine and forming an electronic image of each document... providing at least one user interface device in communication on a communication link" (abstract). An ATM machine such as described in Hyde is a document imaging machine. Furthermore, the system of Hyde has a communication device. It would be obvious to combine the two references at least because the results would be predictable, and would function exactly as they had functioned before the combination. Examiner notes that KSR forecloses the argument that a specific teaching is required for a finding of obviousness (*KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396). The combination would have the functionality of the Cahill system, in that the system would be able to archive and communicate transaction results and document images, and the combination would be in the context of the Hyde ATM system. This combination is substantially as claimed in claim 1.

Regarding claim 5, Applicant argues that the claim is not directed to sending a monthly statement, but instead is directed to sending an alert for the transaction. Examiner is of the opinion that a monthly statement contains an "alert" for each

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transaction that was completed within the statement period, and therefore "sending an alert for the transaction," as recited in claim 5, is anticipated by the statement of what is old and well known. Furthermore, while Applicant argues the Examiner has failed to show a motivation to combine the references, Examiner again notes that KSR forecloses the argument that a specific teaching is required for a finding of obviousness (*KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396). The elements of the claimed invention were known at the time, the elements of the prior art would perform the same function in the combination, and the results are predictable.

Regarding claims 7, 8, 35, 36, 40, and 41, Examiner again notes that KSR forecloses the argument that a specific teaching is required for a finding of obviousness (*KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396).

Regarding claim 2, Applicant argues that the reference "The XML files" makes no mention of any import of data into bank reconciliation software. Examiner respectfully disagrees. As previously cited, the reference teaches "getting an e-mail message from your bank with an XML representation of your bank statement attached... rather than having to key 'cleared check and deposit' information into your accounting system bank reconciliation software, you could simply import the attached XML file to update your files." Examiner is of the opinion that the reference teaches importing the XML file into the bank reconciliation software rather than keying in the information. The entirety of the reference discusses how XML documents save time because files can be imported

rather than having to key in information. Considering the reference as a whole, and the context of the paragraph, it is clear that the "update of files" is within the reconciliation software. Again, incorporation of these features would yield predictable results in combination.

Regarding claim 49, considering the argument in relation to claim 2, above, it is clear that the information can be forwarded to another system (bank reconciliation software), and is therefore taught by the prior art of record.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,
Daniel Kesack
April 28, 2008
/D. K./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691